

REMARKS

Applicants express appreciation for the attention accorded the present Application in the Office Action dated December 22, 2004. In the December 12, 2004, Office Action, Claims 1-23 was pending for consideration. Claims 1, 2, 5-16, 21-23 were rejected under one or more statutory grounds and Claims 3, 4, and 17-20 were objected to.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, the Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following rejections were made:

- (1) claims 1, 2, 5-8, 13-16, 21 and 22 were rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admission; and
- (2) claims 7 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's statement; and
- (3) claims 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's statement as applied to claim 1 above, and further in view of U.S. Pat. No. 6,021,681 (hereinafter "Jezek"); and
- (4) claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Statement as applied to claim 15 above, and further in view of U.S. Pat. No. 5,851,285 (hereinafter "Johnsson"); and
- (5) claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Statement as applied to claim 2 above, and further in view of U.S. Pat. No. 3,074,276 (hereinafter "Moos")

Rejections under 35 U.S.C. § 102

Before discussing the above rejections, it is thought proper to briefly state what is required to sustain such rejections. It is well settled that “[a] claim is anticipated only if each and every element as set forth in the Claims is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. § 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), cert denied, 469 U.S. 851 (1984), “anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference.” “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Rejections under 35 U.S.C. § 102(a)

Before discussing the rejections, Applicant would like to express appreciation for the Examiner’s suggestion of amending the claims to include the definition of “adhesive” as provided in the specification. Applicant has amended the claims according to the Examiner’s suggestions.

Accordingly, claims 1, 2, 5-8, 11, 13-16, 21 and 22 were rejected under § 102(a), as being anticipated by Applicants’ background section. Specifically, Examiner points to the statement in the background section which describes a method of sampling a given area for zinc particulates. The example includes a “wet wipe” swatch which is wiped across a given area to gather particulates. The wipe can then be sealed in a plastic bag and sent to a lab where tests are conducted to determine whether zinc is in the form of a zinc whisker.

In contrast, the presently claimed invention is drawn to a method of sampling for a presence of fragile whisker-like metallic particulates in a data center. Specifically, in claim 1 the method includes the steps of i) providing a tool capable of capturing and retaining the whisker-like metallic particulates in their fragile condition including a whisker-like geometry, wherein the tool comprises an adhesive portion, having adhesion strength greater than water, for extracting the whisker-like particulates; ii) locating a surface of the data center where metallic particulates may be present; and iii) extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition and in a manner enabling characterization of the whisker-like geometry. The tool disclosed provides an adhesion portion having adhesion properties that are greater or stronger than the properties of water. In particular, the tool's adhesion properties are greater than a cloth or paper material impregnated with water such as, a "swatch" or "wet wipe". Therefore the presently invention as claimed in independent claims 1 and 15 cannot be anticipated by the background section since a wet wipe would have less adhesion strength than the tools provided by the claimed invention. Furthermore, Applicants submit that a "wet wipe" would not be capable of capturing, extracting and retaining whisker-like metallic particulates present in substantially their fragile condition and in a manner enabling characterization of the whisker-like geometry because the art of "wiping" an action inherently performed with a wet wipe, will fracture the delicate whisker, destroying its whisker-like geometry. Accordingly, Applicants respectfully submit that the present invention is not anticipated by the cited section because the background section lacks the disclosure of each and every element of the claimed invention and respectfully request that the rejection be withdrawn.

As to the other rejections, Applicants submit that claims 2-14 and 16-23 depend from now allowable claims. Therefore, Applicants submit that the other rejections are now rendered moot and withdrawal of the rejections is respectfully requested.

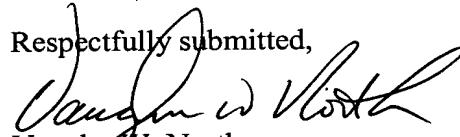
CONCLUSION

In view of the foregoing, Applicants believe that the present patent application is in condition for allowance. Therefore, Applicants respectfully request that the amendments and remarks be considered and the rejections be withdrawn. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to contact Vaughn North at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 22nd day of March, 2005.

Respectfully submitted,


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